

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Status of the claims

Claims 1-46 and 53-54 remain cancelled, and claim 52 remains withdrawn.

Claims 47, 59 and 60 are currently being amended. The amendments add no new matter. Claims 47 and 60 are amended to provide antecedent basis for the term “site” and the term “mammal.” Claim 59 is amended to replace the term “indication” with the term “condition.” Support is found in claim 47. Claim 60 is amended to replace the term “NTP” with the term “SEQ ID NO: 10.”

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 47-52 and 55-60 are now pending in this application.

II. Claim objections

Claim 60 is objected to because the Office Action asserts that the term “NTP” can be any neural thread proteins, [and] related molecules,” and that “NTP” should be replaced with the term “SEQ ID NO: 10.” While not conceding to the correctness of the Examiner’s objection, to expedite prosecution, claim 60 has been amended to replace the term “NTP” with the term “SEQ ID NO: 10.” Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

III. Claim rejections – 35 U.S.C. § 112, second paragraph

Claim 60 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Office Action asserts that the term “site” in the phrase “wherein the NTP is administered at the site” does not have antecedent basis, and that the term “NTP” renders the claim unclear. (Office Action at page 5). Claim 60 (and claim 47) have been amended to provide proper antecedent basis for the term “site.” Claim 60 has also been amended to remove the term “NTP.” Accordingly, the claims are fully compliant with the requirements of 35 U.S.C. § 112, second paragraph, and reconsideration and withdrawal of the rejection is respectfully requested.

IV. Claim rejections – 35 U.S.C. § 112, first paragraph, written description

Claim 60 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action asserts that the term “NTP” in claim 60 encompasses any NTP molecule, including fragments and derivatives and the like. (Office Action at page 5-8). Applicant respectfully traverses the rejection; however, while not conceding to the correctness of the Examiner’s rejection and solely to expedite prosecution, claim 60 has been amended to replace the term “NTP” with the term “SEQ ID NO: 10.” Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

V. Claim rejections – 35 U.S.C. § 103(a)

Claims 47-51, 55-56 and 59-60 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 02/34915 (the ‘915 application) in view of U.S. Patent No. 4,874,779 (the ‘779 Patent) and U.S. Patent No. 6,620,922 (the ‘922 Patent). The Office Action asserts that the ‘915 application discloses methods of treatment and therapeutic and diagnostic assays using a polypeptide which is 100% identical to SEQ ID NO: 10; that the ‘779 Patent discloses a method of treating tumors intratumorally using mitomycin derivatives; and that the ‘922 Patent discloses a method of treating cancer comprising administering a polypeptide “together with an

immunostimulant such a cytokines, GM-XSF or interleukin-1, IL-7 or IL-12. (Office Action at pages 9-10). The Office Action asserts that it would have been obvious for one skilled in the art to “administer the peptide of the ‘779 application intratumorally in combination” with an immunostimulant of the ‘922 Patent with a reasonable expectation of success, because “such administration methods are well known in the art.” (Office Action at page 10). Applicants respectfully traverse the rejection.

A. WO 02/34915 cannot be used as a reference under 35 U.S.C. § 103(a)

The ‘915 application cannot be used as a reference under 35 U.S.C. § 103(a) because it is a 102(e) reference. Per 35 U.S.C. § 103(c),

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (35 U.S.C. § 103(c)).

The ‘915 application was developed by “another person” (“another” includes the inventor and any other persons, *see* MPEP § 706.02(I)), qualifies as prior art under 35 U.S.C. § 102(e) (earliest effective U.S. filing date October 27, 2000, with publication date of May 2, 2002) and was subject to an obligation of assignment to the same person (Nymox Pharmaceuticals Corporation) at the time the claimed invention was made. (*See* Exhibit A, Statement of Common Ownership). Accordingly, the rejection under 35 U.S.C. § 103(a) may be formed solely on the disclosure of the ‘779 Patent and ‘922 Patent, and such a rejection is wholly improper.

B. The ‘779 and ‘922 Patents do not support a finding of obviousness under 35 U.S.C. § 103(a)

The combination of the ‘779 Patent and the ‘922 Patent do not support a finding of obviousness under 35 U.S.C. § 103(a) because the combination of references does not teach or suggest every element of the claimed methods. Specifically, the combination of references does

not teach or suggest methods of treatment using a neural thread protein – particularly the neural thread protein encoded by SEQ ID NO: 10 and SEQ ID NOs: 2-9.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

VI. Conclusion

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date July 18, 2008

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5538
Facsimile: (202) 672-5399

By Michele M. Simkin

Michele M. Simkin
Attorney for Applicant
Registration No. 34,717



Exhibit A

Atty. Dkt. No. 018792-0199

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Paul Averbach

Title: METHODS OF USING
NEURAL THREAD PROTEINS
TO TREAT TUMORS AND
OTHER CONDITIONS
REQUIRING THE REMOVAL
OR DESTRUCTION OF CELLS

Appl. No.: 10/092,934

Filing Date: 3/8/2002

Examiner: Hong SANG

Art Unit: 1643

Confirmation Number: 7362

STATEMENT OF COMMON OWNERSHIP

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

U.S. Patent Applications 10/092,934 and PCT/US01/42813 (WO 02/23915) were commonly owned or subject to an obligation of assignment to the same entity, namely Nymox Pharmaceuticals Corporation, at the time the invention of the 10/092,934 application was made.

The undersigned, being the Attorney of Record for U.S. Patent Application 10/092,934, and duly authorized to act on behalf of Applicant, declares that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both,

under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date

July 18, 2008

By

Michele M. Simkin

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5538
Facsimile: (202) 672-5399

Michele M. Simkin
Attorney for Applicant
Registration No. 34,717